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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,927	12/27/1999	SIVAKUMAR MUTHUSWAMY	CM01363L	9383

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/472,927

Applicant(s)
Muthuswamy et al.

Examiner
Stephen M. Gravini

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10-7-02
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-18 is/are pending in the application.
- 4a) Of the above, claim(s) 15-18 is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 15-18 are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-5 and 7-14, drawn to a subcombination, classified in class 705, subclass 14.
- II. Claims 15-18, drawn to subcombination method, classified in class 705, subclass 10.

Inventions of group I and group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group II has separate utility such as the independently claimed feature including the user computer selectively recording interaction data relative to a location of a curser on a display area and the duration upon with the cursor is left at the specific location on the display area of the interacted network site and transmitting the interaction data to the server hosting the defined space. This feature is not a limitation of the independently claimed invention of group I. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Newly submitted claims 15-18 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the independently claimed subcombination of group II contains a limitation not found in the independently claimed subcombination of group I, as discussed above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed method and system of does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998).

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The independently claimed network, server, and user computer interaction contain recitations of descriptive material that cannot exhibit any functional interrelationship with the way in which computing process are performed and does not constitute a statutory process, machine, manufacture or composition of matter under 35 USC 101. Because the independently claimed invention is directed to non-functional descriptive material which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

Claims 1-5 and 7-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1 and 9 recite "recording interaction data relative to cursor placement and time relative to movement on a specific defined space on the display area of a network site." The specification discusses script event handlers including an on mouse over feature that triggers an event when a user computer cursor moves over an object or an area from outside that object or area. This script event handler discussion does not describe the recited subject matter in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the

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time the application was filed, had possession of the claimed invention because mere assertion of cursor placement does not record interaction data as claimed.

Claims depending upon rejected claims 1 and 9 are also rejected since they depend upon a non-enabling claim. Examiner will treat the claims in light of the prior art under the assumption that claims 1-5 and 7-14 are enabling.

Claim Rejections - 35 USC § 102

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Merriman et al. (US 5,948,061). Merriman et al. discloses a system comprising:

at least one server in communication with the network, the server hosting one or more network sites where each network site includes a display area having one or more defined spaces, each defined space having a predetermined area on the display area of the network site (please see column 2 lines 59-66); and

at least one user computer in communication with the network, the user computer including a browser that selectively interacts with network sites, the user computer further having a cursor manipulated by the user about the display area of an interacted network site, and the user computer selectively recording interaction data relative to cursor placement and time relative to movement on a specific defined space on the display area of the interacted network site and transmitting the interaction data to the server hosting the defined space (column 3 lines 5-23). Merriman et al. also discloses an internet network, website

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network site (column 2 lines 15-20), JavaScript program execution (implicitly taught at column 1 lines 28-43 and column 2 lines 21-23), interaction conclusion transmission (column 2 lines 25-30), frequency and duration cursor interaction recording (column 2 lines 30-36), and web page advertisements (column 1 lines 7-11).

Claims 10-14 are rejected under 35 U.S.C. 102(3) as being anticipated by d'Eon et al. (US 6,006,197). d'Eon et al. discloses a method comprising:

interacting with a network site through a browser on a user computer (please see column 3 lines 2-5);

selectively recording interaction data and time relative to movement on the user computer relative to a cursor placement on a specific defined space on the display area of the interacted network site; (column 4 lines 23-34); and

transmitting the interaction data to the server hosting the defined space (column 5 lines 7-61). d'Eon et al. also discloses an internet network and browser interaction (column 1 lines 30-35), JavaScript program execution through cursor placement (implicitly taught at column 4 lines 54-56), interaction conclusion transmission (column 3 lines 37-46), and frequency and duration cursor interaction recording (column 3 lines 7-35).

Response to Arguments

Applicant's arguments filed October 7, 2002 have been fully considered but they are not persuasive.

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Enablement & reasonable skilled artisan conveyance

Applicant argues that the specification discusses the rejected non-enabling feature rejected above. However to one skilled in the art the independently claimed feature of recording interaction data relative to cursor placement and time relative to movement on a specific defined space on the display area of a network site is not discussed in enough adequate detail to allow reasonable conveyance of that concept. The specification merely introduces that concept which is claimed as a concept.

Anticipation & obviousness

Applicant's arguments fail to comply with 37 CFR 1.111(b) because the arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes the invention from the references and because the arguments do not clearly point out the patentable novelty which the inventors think that the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured. Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
February 7, 2003